

REMARKS

In response to the Office Action of January 5th 2004, the Applicants hereby respond and file a Continuation Application with the claims in amended form as shown in this Preliminary Amendment.

The Examiner has previously rejected claims 1-3, 6, 8-12 and 14-20 under 35 U.S.C. 102(b) in view of Ichahashi et al. (US 5,792,731). Applicants respectfully traverse and respond in this Preliminary Amendment to the previous rejections.

Applicants have amended claim 1 by adding the limitation of claim 16, thereby adding the requirement for a friction modifier of a glycerol ester or a borated glycerol ester to the claimed lubricating composition. Support for this amendment is found on page 18, line 23 to page 19, line 12. Ichahashi does not anticipate, teach, suggest or disclose Applicants friction modifier in the claimed lubricating composition. In view of this amendment the rejection under 35 U.S.C. 102(b) in view of Ichahashi should be withdrawn.

In previous correspondence mailed on 3rd August 2000 the Examiner further rejected claim 1 combined with claim 16 under 35 U.S.C. 103(a) as unpatentable over Hollinghurst et al. (US 3,652,410) and Ohtani et al. (US 5,344,579). The Examiner contended that the references when combined teach Applicants invention because Hollinghurst teaches a multifunctional lubricant additive (transmission) comprising a basic detergent, a friction modifier and an organic phosphite. As a consequence the Examiner has used Hollinghurst to teach all of the limitations of Applicants invention. Applicants respectfully traverse.

Hollinghurst discloses a lubricating oil comprising a basic detergent, a friction modifier and an organic phosphite. The friction modifiers taught by Hollinghurst are a sulphurised fat, a sulphur containing compound selected from an alkyl sulphide, an alkyl polysulfide and a sulfurised olefin (see column 4, line 60 to column 5, line 3). In contrast, Applicants invention requires a glycerol ester or a borated glycerol ester friction modifier. Hollinghurst does not teach, suggest or disclose Applicants invention that requires a glycerol ester or a borated glycerol ester friction modifier.

Ohtani discloses a lubricant composition with supplemental friction modifiers as described in column 7, lines 14-34. The supplemental friction modifiers disclosed by Ohtani generically define a list of known classes that the Examiner stated "the compounds are

equivalent for the purpose of modifying friction.” Applicants respectfully disagree in that Ohtani at column 7 lines 15-20 states that care must be taken when evaluating supplemental friction modifiers because certain candidates may adversely affect the friction properties. Indeed given the limited guidance, a person skilled in the art would have no expectation that one class is more suitable than the others disclosed in Ohtani. Accordingly, Ohtani does not teach, suggest, or disclose to a person skilled in the art to choose one class of friction modifier from the list given and it does not specifically disclose or teach Applicants friction modifiers from its generic lists of friction modifiers.

Ichahashi in combination with Ohtani and/or Hollinghurst does not teach Applicants invention in that Ichahashi does not teach suggest, or disclose the person skilled in the art to use the friction modifiers disclosed in Ohtani or Hollinghurst. Therefore combining Ichahashi with Ohtani and/or Hollinghurst would produce a lubricating composition without the presence of the glycerol ester or the borated glycerol ester, which is not taught or suggested by any of the references. Given no direction by the prior-art to combine a basic salt with a friction modifier from the glycerol ester or the borated glycerol ester is not obvious over any combination of Ichahashi, Ohtani or Hollinghurst.

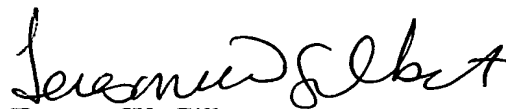
For the reason set forth above, Applicants believe the present invention is novel and not obvious over the cited prior-art. Applicants respectfully request the Examiner to remove the 35 USC 102(b) rejection and find all claims allowable in the Continuation Application. Furthermore, Applicants believe there should be no 35 USC 103(a) rejections of the prior-art cited against the claimed invention. Therefore, Applicants believe the Examiner will find all claims allowable.

Preliminary Amendment
Docket No. 2926B/R-02

The Commissioner is authorized to charge the required fee of \$770.00 for the filing of the Continuation application to The Lubrizol Corporation Deposit Account No. 12-2275. If any additional fees are due, the Commissioner is also authorized to charge such fees to this same deposit account. A duplicate copy of this document is submitted for such purposes.

Respectfully submitted,

THE LUBRIZOL CORPORATION

A handwritten signature in black ink, appearing to read "Teresan W. Gilbert", is written over the printed name.

Teresan W. Gilbert

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